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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/026,302	12/19/2001	Vladimir V. Martin	2086	8077
23358	7590	09/03/2004	EXAMINER	
KOREN ANDERSON MOLECULAR PROBES, INC. 29851 WILLOW CREEK ROAD EUGENE, OR 97402-9132			KIFLE, BRUCK	
ART UNIT		PAPER NUMBER		1624

DATE MAILED: 09/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.	10/026,302	
Examiner	MARTIN ET AL.	
Bruck Kifle, Ph.D.	Art Unit 1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 14 July 2004.

2a) This action is **FINAL**.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1, 3, 5-10, 12, 41-21, 25-32 and 34-55 is/are pending in the application.

4a) Of the above claim(s) 3,5,7,10,14,16-20,25-32,34,35,41 and 51-55 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1,4,6,8,9,12,15,21,36-40 and 42-50 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All    b) Some \* c) None of:  
1. Certified copies of the priority documents have been received.  
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) Notice of References Cited (PTO-892)  
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

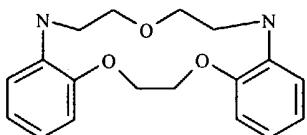
4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_

5) Notice of Informal Patent Application (PTO-152)  
6) Other: \_\_\_\_\_

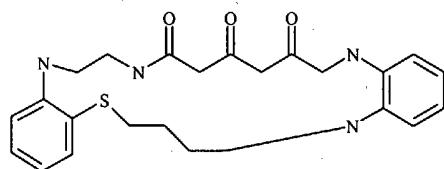
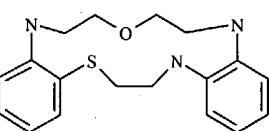
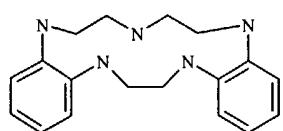
***Election/Restrictions***

Applicant's election with traverse of group I in the reply filed on 7/14/04 is acknowledged. The traversal is on the ground that the inventions of group I and II are not distinct or independent because the compounds are not made or used independently. This is not found persuasive because compounds embraced by claim 1 are indeed patentably distinct, raise different issues of patentability and are extremely burdensome for the office to search and examine.

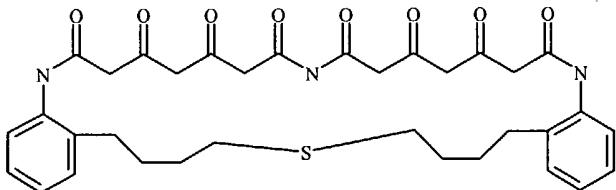
The elected core is



Claim 1 embraces cores, such as,



and



The search of each such core has to be done which is not possible without serious burden.

The above four structures signify a tiny subset of what is embraced by claim 1 which does not include further ring fusions. There are thousands of different cores present in the instant claims

and these compounds further contain sugars, proteins, nucleic acids, polymers, cells, viruses, etc. which are classified separately and examined by different groups at the USPTO.

Compounds, corresponding compositions, a method of use and a process of making that are of the same scope are considered to form a single inventive concept. The compounds instantly claimed are not so linked as to form a single inventive concept. The compounds are so diverse in scope that a prior art anticipating one compound under 35 USC 102 would not render obvious another compound of the same claim under 35 USC 103. This is evidentiary of patentably distinct and independent inventions.

The requirement is still deemed proper and is therefore made FINAL.

Claims 3, 5, 7, 10, 14, 16-20, 25-32, 34, 35, 41, 51 and 52-55 along with subject matter not falling under elected group I of the remaining claims are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 7/14/04.

#### ***Claim Rejections - 35 USC § 112***

Claims 1, 4, 6, 8, 9, 12, 15, 21, 36-40 and 42-50 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

i) The groups at  $R_X$  are written as compounds and not radicals. Compounds do not have points of attachments. See for example, ester or anhydride. These are classes of compounds. Applicant's intention may be alkoxycarbonyl for ester, but this is not reflected in the claims.

- ii) Regarding  $S_C$  as a "conjugated substance," Applicants response appears to state that a conjugated substance is what is being formed. This definition does not say what  $S_C$  is, rather what the compound as a whole is. The variable  $S_C$  is still not defined.
- iii) Claim 21 is improperly presented as a composition claim. A composition requires the presence of at least two components (see also claims 36-40). Claim 21 is a duplicate of claim 1.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bruck Kifle, Ph.D. whose telephone number is 571-272-0668. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund J. Shah can be reached on 571-272-0674. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.



Bruck Kifle, Ph.D.  
Primary Examiner  
Art Unit 1624

BK  
September 1, 2004